

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JORGEN PEDERSEN-RASK

Appeal No. 97-2581
Application 29/031,665¹

ON BRIEF

Before THOMAS, MEISTER and PAK, *Administrative Patent Judges*.

MEISTER, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal from the following design claim:

The ornamental design for a LID FOR A CONTAINER as shown and described.

The references relied upon by the examiner by the examiner are:

¹ Application for patent filed December 1, 1994.

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Lampe	Des. 281,673	Dec. 10, 1985
Rymoen	4,972,955	Nov. 27, 1990
Ferrero	WO 93/00267	Jan. 7, 1993

The claim stands rejected under 35 U.S.C. § 103 as being unpatentable over Ferrero in view of Lampe and Rymoen.² According to the examiner:

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified the Ferrero lid by providing it with a plain inside configuration in lieu of it's annular ribs similar to [sic] as suggested by Lampe. Furthermore, to eliminate the surrounding circular ring, element 7, of the Ferrero lid so as to have a plain configuration similar to [sic] as taught by Rymoen would result in an article quite similar in general overall appearance of [sic, to] the design claimed by appellant. [Answer, pages 3 and 4.]

In support of this position the answer states:

Appellant has also argued that the opening of the claimed design has an inverted dome and is quite visible. The basic reference to Ferrero is substantially similar in appearance to that of appellant's design. To modify the minor features of the Ferrero lid would have been obvious to a designer as suggested by the secondary Lampe and Rymoen references. The construction of the depression of

the lid, as argued by appellant is barely [sic, barely] discernable and have a [sic, has] little or no effect on the overall appearance of the design. The difference is insignificant and does not influence the overall appearance of the lid to the extent

² Neither the final rejection nor the answer set forth a clear statement of the rejection together with the appropriate statutory basis. However, considering paragraphs (6), (7) and (11) of the answer, as a whole, it is readily apparent that this is the intended rejection. The appellant is not prejudiced by this interpretation inasmuch as under "Issues" on page 2 of the brief the issue is correctly articulated as "whether the claimed design is unpatentable over . . . Ferrero . . . in view of . . . (Lampe) and . . . (Rymoen)."

that it establishes unobviousness in it's configuration. An average observer would merely view it [as] a minor modification to the lid. Furthermore, the cylinder end would be hidden in use and would not be visible in it's normal use unless someone looks closely inside the lid. [Page 5.]

On the other hand, the main thrust of the appellant' position is that

. . . there is no teaching in any of the secondary references of the depression of the present lid that replace[s] the simple opening of Ferrero. As may be seen quite clearly in Fig. 1, the opening of the present design is surrounded by a cylindrical inner wall which terminates in an inverted dome, see Figs. 4 and 5. This inner wall is quite visible when viewed as in Fig. 1 and the inverted dome at the bottom of the depression may be seen when viewed from the top or bottom of the present lid. Thus, the similarity between the present design and the cited references ends when the present lid is viewed from a direction other than the side. [Brief, pages 3 and 4.]

OPINION

Having carefully considered the respective positions advanced by the appellant in the brief and the examiner in the answer, it is our conclusion that the references relied on by the examiner fail to establish the obviousness of the design claim on appeal within the meaning of 35 U.S.C. § 103.

Even if we were to agree with the examiner that it would have been obvious to modify the lid of Ferrero in view of the teachings of Lampe and Rymoen in the manner proposed, we do not believe that the overall appearance of the appellant's design is suggested. The examiner recognizes that there is nothing in the combined teachings of the relied on prior art which would have fairly suggested the inverted dome depression which the appellants argue is a patentably distinguishing feature, but nevertheless seeks to dismiss such a difference as "minor." We do not agree.

As the court in *In re Blum*, 374 F.2d 904, 907, 153 USPQ, 177, 179-180 (CCPA 1967) stated

there are *no* portions of a *design* which are "immaterial" or "not important." A design is a unitary thing and all of its portions are material in that they contribute to the appearance which constitutes the design.

The appearance may be the result of a peculiarity of configuration, or of ornamentation, or of both. *See Gorham Mfg. Co. v. White*, 81 U.S. (14 Wall.) 511, 525 (1872) and *In re Schnell*, 46 F.2d 203, 209, 8 USPQ 19, 25 (CCPA 1931).

Here, as the appellant has argued, the claimed design includes a relatively shallow depression in the form of a cylindrical wall terminating in an inverted dome; and this inverted

dome is clearly visible from (1) both the top and the bottom of the lid when the lid is off the container with which it is intended to cooperate or (2) from the top when the lid is on the container with which it is intended to cooperate. This depression on the appellant's lid, in our view, creates a distinctive effect which differs significantly in overall appearance from the lids of the relied on prior art.³

As to the examiner's contention that the "cylinder end would be hidden from use," we must point out that (as we have noted above) not only is the inverted dome visible when it is applied to the container, it is visible to a user from both the top and bottom when the lid is removed from the container, e.g., either to add or remove contents. This being case, both the bottom and the top of the lid are visible in its "normal and intended use" (*see In re Webb*, 916 F.2d 1553, 1557-58, 16 USPQ2d 1433, 1436 (Fed. Cir. 1990)) and thus the appearance of

³ Apparently recognizing the deficiencies of the relied on prior art, the examiner on page 6 of the answer made reference to Worsley (U.S. Design Patent 195,372) and Mineo (U.S. Design Patent 268,483). We must point out, however, that such a procedure by the examiner is totally improper and inappropriate since these references do not form a part of the examiner's final rejection of the appealed claim. If a reference is relied upon in any capacity to support a rejection, the reference should be positively included in the statement of the rejection. See Manual of Pat. Examining Procedure (MPEP) § 706.02(j) (6th ed., Rev. 3 Jul. 1997), *In re Hoch*, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970) and *Ex parte Raske*, 28 USPQ2d 1304-05 (Bd. Pat. App. & Int. 1993). For this reason, our consideration of the examiner's rejections is based solely on the references which have been positively included in the statement of the rejection.

the bottom of the lid is also consequential to the design of the lid as a whole (*cf. Power Controls Corp. v. Hybrinetics, Inc.*, 806 F.2d 234, 239, 231 USPQ 774, 778 (Fed. Cir. 1986) wherein the shape of **interior**, as well as exterior, features of a package were considered by the court).

Since we are of the opinion that the difference in the lid which we have noted above creates a distinctive overall appearance which is not suggested by the relied on prior art, we will not sustain the rejection of the appealed design claim under 35 U.S.C. § 103.

The decision of the examiner is reversed.

REVERSED

JAMES D. THOMAS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
)	APPEALS AND
JAMES M. MEISTER)	INTERFERENCES
Administrative Patent Judge)	
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CHUNG K. PAK)	
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